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| 09/764,431 | 01/19/2001 | Yoshikazu Watanabe | 202127US2 | 7063 |

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| EXAMINER |
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JONES, HEATHER R

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| ART UNIT | PAPER NUMBER |
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2616

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,431

Applicant(s)

WATANABE, YOSHIKAZU

Examiner

Heather R. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36,38-41 and 43-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36,38-41 and 43-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/11/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Page 21, line 5 – Page 22, line 18, filed August 1, 2005, with respect to the rejection(s) of claim(s) 1-33 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a newly submitted IDS reference.
2. Applicant's arguments, see Page 19, line 5 – Page 20, line 5, filed August 1, 2005 with respect to claims 34-36, 38-41, and 43-49 have been fully considered and are persuasive. The rejections of claims 34-36, 38-41, 43-48, and 49 have been withdrawn.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-36, 38-41, and 43-49 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-49 of copending Application No. 09/537,405. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in Application No. 09/537,405 encompass the claims in this case. Furthermore, decompress and expand are obvious variations of one another, as well as switching unit and selection unit are.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

5. Claim 8 is objected to because of the following informalities: Claim 8 should depend from claim 7 and not claim 6. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honma (U.S. Patent 6,304,313) in view of Safai et al. (U.S. Patent 6,167,469) in view of Nemoto et al. (JP 9-23375).

Regarding claim 1, Honma discloses in Fig. 1 a digital camera (101) having a normal shooting mode and a text shooting mode (col. 14, lines 31-35), comprising: an image pickup unit (103) which captures an image of a subject and converts the image into image data (col. 5, lines 33-38); a compressing unit (106) which generates compressed image data by compressing the image data outputted from the image pickup unit (col. 5, lines 33-38); a storage unit (107) which stores the compressed image data (col. 5, line 38); a decompressing unit (108) which decompresses the compressed image data (col. 5, lines 39-40); a switching unit (a switch on the user interface (111)) which switches the normal shooting mode to the text shooting mode and vice versa (col. 6, lines 34-44); and an image processing unit (117) which performs image processing to the image data, wherein, after the decompressing unit decompresses the compressed image data of an image captured in the text shooting mode and stored in the storage unit, the image processing unit effects image processing appropriate to a transmission destination to resulting decompressed image data (col. 5, line 66 – col. 6, line 9). However, Honma fails to explicitly teach a digital camera with which a destination to receive the image data can be selected as well as the image processing unit detects a shooting angle of the digital camera with respect to the subject.

Referring to the Safai et al. reference, Safai et al. discloses a digital camera comprising with which a destination to receive the image data can be selected (abstract; col. 8, lines 1-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teaching of allowing the user to send image data to various locations as disclosed by Safai et al. with the digital camera disclosed by Honma in order to make the camera more versatile by providing the user with more options than just sending an image to a printer. However, Honma in view of Safai et al. fail to disclose a digital camera with an image processing unit detects a shooting angle of the digital camera with respect to the subject.

Referring to the Nemoto et al. reference, Nemoto et al. discloses a digital camera wherein the image processing unit detects a shooting angle of the digital camera with respect to the subject (constitution).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the angle detection unit as disclosed by Nemoto et al. with the digital camera disclosed by Honma in view of Safai et al. in order to provide a proper quality image in accordance with the photographic conditions (the position of the subject).

Regarding claim 2, Honma in view of Safai et al. in view of Nemoto et al. discloses all the limitations as previously discussed with respect to claim 1 as well as disclosing that in the text shooting mode, the storage unit stores the shooting condition data (Honma: col. 6, lines 33-39 - monochrome color; col. 7, lines 3-12 – perspective correction) in a one-to-one correspondence with the

compressed image data, and the image processing unit effects the image processing to the image data based on the shooting condition data.

Regarding claim **3**, Honma in view of Safai et al. in view of Nemoto et al. discloses all the limitations as previously discussed with respect to claim 1 as well as disclosing that the digital camera further comprises a data communication unit (116) which allows a data communication with an external device (Honma: col. 5, lines 62-65).

Regarding claim **4**, Honma in view of Safai et al. in view of Nemoto et al. discloses all the limitations as previously discussed with respect to claims 1 and 3 as well as Safai et al. further disclosing that the digital camera further comprises: a memory (212) which stores name and/or telephone number and/or address of a destination (col. 2, lines 45-48; col. 9, lines 15-45), and an image deleting flag that specifies whether the image data should be deleted or not after transmission in a one-to-one correspondence (Fig. 4F; col. 12, lines 55-60; delete option check box (472)); and a deleting unit (trash (442); Fig. 4C) which deletes the image data that has been transmitted through the data communication unit in accordance with the image deleting flag stored in the memory (col. 10, lines 60-67).

Regarding claim **5**, Honma in view of Safai et al. in view of Nemoto et al. discloses all the limitations as previously discussed with respect to claims 1 and 3 including that digital camera further comprises a deleting unit which deletes the image data that has been transmitted through the data communication unit

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depending on a transmission destination (Safai et al.: col. 12, lines 55-60; col. 8, lines 61-67 – email or physical mail address).

Regarding claim **6**, Honma in view of Safai et al. in view of Nemoto et al. discloses all the limitations as previously discussed with respect to claims 1, 3, and 4 including that a manipulator is allowed to arbitrarily set a content of the memory (Safai et al.: col. 3, lines 23-28 – operator can delete unwanted images using the Trash icon to free up memory space).

Regarding claims **7-11**, please see the rejection basis/rationale as described in claims 1 and 3-6 (respectively) above.

8. Claims 12-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honma (U.S. Patent 6,304,313) in view of Safai et al. (U.S. Patent 6,167,469) in view of Fellegara et al. (U.S. Patent Application Publication 2001/0015760) in view of Nemoto et al. (JP 9-23375).

Regarding claim **12**, Honma discloses in Fig. 1 a digital camera (101) having a normal shooting mode and a text shooting mode (col. 14, lines 31-35), comprising: an image pickup unit (103) which captures an image of a subject and converts the image into image data (col. 5, lines 33-38); a compressing unit (106) which generates compressed image data by compressing the image data outputted from the image pickup unit (col. 5, lines 33-38); a storage unit (107) which stores the compressed image data (col. 5, line 38); a decompressing unit (108) which decompresses the compressed image data (col. 5, lines 39-40); a switching unit (a switch on the user interface (111)) which switches the normal

shooting mode to the text shooting mode and vice versa (col. 6, lines 34-44); and an image processing unit (117) which performs image processing to the image data, wherein, after the decompressing unit decompresses the compressed image data of an image captured in the text shooting mode and stored in the storage unit, the image processing unit effects image processing appropriate to a transmission destination to resulting decompressed image data (col. 5, line 66 – col. 6, line 9), and further recompresses resulting processed image data (col. 5, lines 38-42). However, Honma fails to explicitly teach a digital camera comprising with which a destination to receive the image data can be selected along with the image processing unit effects processing including clipping, small-step gray scaling, and resolution changing to resulting decompressed image data as well as the image processing unit detects a shooting angle of the digital camera with respect to the subject.

Referring to the Safai et al. reference, Safai et al. discloses a digital camera comprising with which a destination to receive the image data can be selected (abstract; col. 8, lines 1-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teaching of allowing the user to send image data to various locations as disclosed by Safai et al. with the digital camera disclosed by Honma in order to make the camera more versatile by providing the user with more options than just sending an image to a printer. However, Honma in view of Safai et al. still fail to disclose an image processing

unit effects processing including clipping, small-step gray scaling, and resolution changing to resulting decompressed image data.

Referring to the Fellegara et al. reference, Fellegara et al. discloses a digital camera with an image processing unit (70) (paragraph [0056]) for processing clipping, small-step gray scaling, and resolution changing to resulting decompressed image data (paragraph [0056] – cropping and resolution reducing).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of image processing as disclosed by Fellegara et al. with the digital camera as disclosed by Honma in view of Safai et al. in order to minimize storage space and to allocate space for flash memory as disclosed by Fellegara et al. (paragraph [0056]). However, Honma in view of Safai et al. in view of Fellegara et al. fail to disclose a digital camera with an image processing unit detects a shooting angle of the digital camera with respect to the subject.

Referring to the Nemoto et al. reference, Nemoto et al. discloses a digital camera wherein the image processing unit detects a shooting angle of the digital camera with respect to the subject (constitution).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the angle detection unit as disclosed by Nemoto et al. with the digital camera disclosed by Honma in view of

Safai et al. in view of Fellegara et al. in order to provide a proper quality image in accordance with the photographic conditions (the position of the subject).

Regarding claim **13**, Honma et al. in view of Safai et al. in view of Fellegara et al. in view of Nemoto et al. discloses all the limitations as previously discussed with respect to claim 12 as well as disclosing that in the text shooting mode, the storage unit stores the shooting condition data (Honma: col. 6, lines 33-39 - monochrome color; col. 7, lines 3-12 – perspective correction) in a one-to-one correspondence with the compressed image data, and the image processing unit effects the image processing to the image data based on the shooting condition data.

Regarding claim **14**, Honma et al. in view of Safai et al. in view of Fellegara et al. in view of Nemoto et al. discloses all the limitations as previously discussed with respect to claim 12 as well as disclosing that the digital camera further comprises a data communication unit (116) which allows a data communication with an external device (Honma: col. 5, lines 62-65).

Regarding claim **15**, Honma et al. in view of Safai et al. in view of Fellegara et al. in view of Nemoto et al. discloses all the limitations as previously discussed with respect to claims 12 and 14 as well as Safai et al. further disclosing that the digital camera further comprises: a memory (212) which stores name and/or telephone number and/or address of a destination (col. 2, lines 45-48; col. 9, lines 15-45), and an image deleting flag that specifies whether the image data should be deleted or not after transmission in a one-to-one

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correspondence (Fig. 4F; col. 12, lines 55-60; delete option check box (472)); and a deleting unit (trash (442); Fig. 4C) which deletes the image data that has been transmitted through the data communication unit in accordance with the image deleting flag stored in the memory (col. 10, lines 60-67).

Regarding claim **16**, Honma et al. in view of Safai et al. in view of Fellegara et al. in view of Nemoto et al. discloses all the limitations as previously discussed with respect to claims 12 and 14 including that digital camera further comprises a deleting unit which deletes the image data that has been transmitted through the data communication unit depending on a transmission destination (Safai et al.: col. 12, lines 55-60; col. 8, lines 61-67 – email or physical mail address).

Regarding claim **17**, Honma et al. in view of Safai et al. in view of Fellegara et al. in view of Nemoto et al. discloses all the limitations as previously discussed with respect to claims 12, 14, and 15 including that a manipulator is allowed to arbitrarily set a content of the memory (col. 3, lines 23-28 – operator can delete unwanted images using the Trash icon to free up memory space).

Regarding claims **18-22**, please see the rejection basis/rationale as described in claims 12 and 14-17 (respectively) above.

Regarding claims **23-28**, please see the rejection basis/rationale as described in claims 12-17 (respectively) above.

Regarding claims **29-33**, please see the rejection basis/rationale as described in claims 12 and 14-17 (respectively) above.

Allowable Subject Matter

9. Claims 34-36, 38-41, and 43-49 are allowable if the double patenting is overcome.
10. The following is a statement of reasons for the indication of allowable subject matter: Prior art fails to teach or fairly suggest a digital camera having a normal shooting mode and a text shooting mode, comprising:
 - a. A display unit that controls display and non-display of the guidance on the monitor depending on a transmission destination, wherein the guidance is used to notify a shooting condition of a text while displaying on the monitor the video of the subject before being shot (claims 34-36, 38-41, 43, 48, and 49).
 - b. A shooting angle detecting unit, wherein shooting is started when the shooting angle of the digital camera with respect to the subject becomes substantially perpendicular (claims 44-47).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather R. Jones whose telephone number is 571-272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Heather R Jones
Examiner
Art Unit 2616

HRJ
December 21, 2005

Robert Chaher
ROBERT CHAHER
PRIMARY EXAMINER